| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/671,162 | 09/25/2003 | Barry J. Gilhuly | 1400-1072C4 | 7030 |

| | | | EXAMINER |
|---|---|---|---|
| 47243 7590 10/06/2006 | | | REILLY, SEAN M |

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| ART UNIT | PAPER NUMBER |
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| 2153 | |

DATE MAILED: 10/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *30 May 2006*.

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-5, 8-15, 18-28, 31-33 and 55-69* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5, 8-15, 18-28, 31-33, 55-69* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *8/7/06.*

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____ .

## DETAILED ACTION

This Office action is in response to Applicant's amendment and request for reconsideration filed on May 30, 2006. Claims 1-5, 8-15, 18-28, 31-33, 55-69 are presented for further examination. All independent claims have been amended.

### *Response to Arguments*

Applicant's arguments are moot in view of the new grounds of rejection set forth.

### *Information Disclosure Statement*

The information disclosure statement (IDS) submitted on August 7, 2006 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### *Priority*

It is noted for the record that the effective filing data for the subject matter in the pending claims filed September 12th 2005 is 09/23/1999. While written description support for the subject matter amended to independent claim 1 and also incorporated within new independent claim 55 exists in application 09/401868 filed September 23rd 1999, no such support exists in application 09/087623 filed May 29th, 1998. Accordingly, the effective filing date for all pending claims is September 23rd 1999.

### · *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

1.  **Claims 1-5, 8-15, 18-24, 31, 32, 55-62, and 66-69 are rejected under 35 U.S.C. 103(a) as**

    **being unpatentable over AirMobile Communication Server Guide ("AirMobile**

    **Software for Lotus cc:Mail Wireless," Motorola Publication, 1995, hereinafter**

    **"AirMobile") and AirMobile Communication Client Guide ("AirMobile Software for**

    **Lotus cc:Mail Wireless," Motorola Publication, 1995, hereinafter "AirMobile Client")**

    **and Birrell et al. (U.S. Patent Number 6,185,551; hereinafter Birrell) and Carthy et al.**

    **(MAPI Developers Forum post "MAPI Notification" April 12, 1996; hereinafter**

    **Carthy).**

    In considering claim 1, AirMobile discloses the claimed redirection method including

detecting a new data item for the user at the messaging host system (cc:Mail Post Office server,

Fig. 1), forwarding a copy of the data item to a redirector host system (AirMobile Wireless for

cc:Mail Server, Fig. 1), configuring a set of filtering rules for use by the redirector host system in

determining whether the new data item should be redirected to the user's mobile device

(AirMobile pgs 10-11 or pg 26); providing an interface that enables the user to remotely

configure and reconfigure the filtering rules (AirMobile Client pg 41), and that also enables the

user to remotely activate and deactivate the redirector host system for the user (AirMobile Client

pg 17); if the new data item passes through the user-configured filtering rules and the redirect

host system is activated, then packaging the data item in an electronic envelope and transmitting

the electronic envelope to the user's mobile device (pp. 10-11, describing the messaging system

and the filtering of messages at the redirector host system, see also pp. 25-26, 35).

The AirMobile server and client guides disclosed the invention substantially as claimed

however, neither the AirMobile server guide nor the AirMobile client guide disclosed that the

configuration interface is a web page interface.    Nonetheless, it was widely known in the art at

the time of the invention to configure programs remotely via a web interface, as evidenced by

Birrell. In an analogous electronic messaging system, Birrell disclosed an email system executed

on a server or group of servers (Col 4, lines 6-14). Users of the email system access all aspects

of the system remotely through a web page interface (Col 13, lines 26-31), including the

configuration of electronic mail filters (Col 11, lines 45-53). Birrell further disclosed that such a

web based interface system is advantageous since users can connect to the system and perform

any mail service from any web-connected client computer, thereby allowing users of the service

to be mobile by moving among different clients at will (Col 4, lines 21-42).    Thus, it would have

been obvious to one of ordinary skill in the art at the time of the invention to incorporate the web

based interface system as disclosed by Birrell within the AirMobile system, so that users are able

to connect to the system and perform any mail service from any web-connected client computer,

thereby allowing users of the services to be mobile by moving among different clients at will.

AirMobile also failed to specifically recite that the redirector host system is

operable to push the copy of the new data item responsive to *an automatically generated*

*notification relating to the new data item*.    AirMobile disclosed a server side push technology

(pg 31 ¶ 1-3), where the server must internally poll for the arrival on new messages in a user's

mailbox. Nonetheless Examiner maintains that such an automatic notification must occur in the

system in order for the actual forwarding software to be invoked within the computer system.

Furthermore even if one were to argue persuasively that such a notification is not inherent then

Examiner maintains that adding a new data item automatic notification feature would have been

an obvious modification to AirMobile at the time of Applicant's invention, in view of at least

Carthy. In a similar art, Carthy disclosed an e-mail system where the notification of new

messages in a user's mailbox is sent **automatically,** as opposed to polling, using an extended

MAPI IMAPIadviseSink notification (See the Carthy post describing "full asynchronous"

notification in extended MAPI). Carthy further disclosed that in order to receive these automatic

notifications the system must register with a software interface associated with the messaging

server (i.e. registering with the ImsgStore to receive adviseSinks). Cathy also disclosed that

automatic notification is preferable to polling (see the Cohen post below: "Today I do a polling

on each mailbox : I open a connection through MAPI functions, I consult, I notify if new mail,

and I close the connection. Then I go to the next mailbox and do the same actions. It's not great

☹. So I'd like to know whether –there- exists another way to notify with MAPI, especially a

"fully asynchronous" notification"). Automatic notification is preferable to polling for

detecting the arrival of new messages since the detection process is more efficient. For example

the system no longer has the delay associated with polling each user's mailbox and is instead

alerted immediately of the arrival of new messages. Additionally less system resources are

consumed since the system no longer has to poll the mailbox of each user in order to detect new

messages. Thus, it would have been obvious to one of ordinary skill in the art at the time of the

invention to incorporate the automatic notification functionally disclosed by Carthy within

AirMobile's system, since Carthy disclosed automatic notification is preferable to polling and

further since the use of automatic notification is more efficient.  Again automatic notification is

more efficient since the system is alerted immediately of the arrival of new messages and less

system resources are consumed.

Claims 2-5 are disclosed on page 10 of AirMobile.

Claim 8 is further disclosed by AirMobile (see AirMobile, pp. 26-27, wherein an

electronic envelope is inherently necessary to send messages between the host and the mobile

device).

In considering claim 9 AirMobile further discloses sending replies from the mobile

device to the redirector host system (p. 26, describing messages sent by the mobile device).

In considering claim 10, the messages sent from the mobile device to the redirector server

will necessarily be addressed using the address of the redirector host system.

Claims 11-12 disclose the analogous reverse steps as claim 1, and thus are rejected under

the same rationale as claim 1.

In considering claim 13, AirMobile will necessarily complete the claimed steps of receiving a reply received at the redirector host system, reconfiguring address information associated with the reply, and sending the reconfigured reply data to a destination using an electronic address included in the reply data item (i.e. the messages sent from the mobile device are intended for outside recipients, so must include the address of those recipients and must have addresses reconfigured upon redirection at the redirection host system).

In considering claim 14, AirMobile further discloses the claimed gateway, and thus sending messages in the electronic envelope through the gateway (Fig. 1, wherein the "Mobidem" serves as the gateway).

Claims 15-24 are disclosed in the same sections of AirMobile discussed previously.

Claims 31 and 32 are disclosed on page 17 of AirMobile.

Claims 55-62 and 66-69 are not patentably distinct over claims 1-5, 8-15, 18-24, 31, and 32. Thus, they are rejected using a similar rationale.

2. Claims 25-28 and 63-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over AirMobile and AirMobile Client and Birrell, in view of Nelson (U.S. Patent No. 6,061,718).

In considering claims 25-26, AirMobile does not disclose that the e-mail system is run by an ISP. Nonetheless, it is well known to use e-mail over the Internet on an e-mail service run by an ISP, as evidenced by Nelson (Nelson, col. 5, line 65 – col. 6, line 4). Thus, it would have

been obvious for the e-mail system taught by AirMobile to be run by an ISP because that would

increase business with the ISP and would allow users to access mail from anywhere in the world.

In considering claim 27, the combined system of AirMobile and Nelson will perform the

steps of including a forwarding database for detecting whether new data items received at the

ISP mail server should be forwarded to the redirector host system and for determining the

address of the redirector host system (AirMobile, p. 13, "Note").

In considering claim 28, the combined system of AirMobile and Nelson will necessarily

connect the messaging host system (i.e. ISP server) and redirector host system over the Internet.

Claims 63-65 are not patentably distinct over claims 25-28. Thus, they are rejected using

a similar rationale.

3. **Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over AirMobile and**

   **AirMobile Client, Birrell, and Carthy, in view of LookSmart ("Motorola Brings**

   **AirMobile Software Products to the DCPD Network; Motorola Provides Mobile**

   **Corporate cc:Mail Users with Flexibility to Use Any Major Wireless Data Network,"**

   **Business Wire, January 1996).**

   In considering claim 33, LookSmart describes that AirMobile uses compression. It

would have been obvious to include compression the in AirMobile system to save network
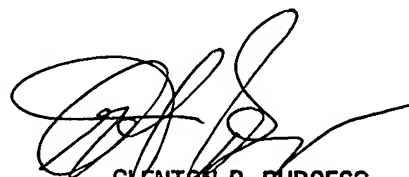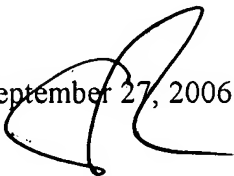
bandwidth.

### *Conclusion*

The prior art made of record, in PTO-892 form, and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sean Reilly whose telephone number is 571-272-4228. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

September 27, 2006

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